

REMARKS

Claims 8-10 are pending in this application. In the Office Action, the Examiner rejected claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Taivitie et al. (U.S. Patent No. 6,133,884) in view of Klatt et al. (U.S. Patent No. 5,877,488).

Applicant respectfully traverses the rejection.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claim 8 recites a data processing apparatus including, among other things, "a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot." Taivitie and Klatt, whether taken alone or in combination, do not disclose or suggest at least this element of claim 8.

In the Office Action, the Examiner alleged that Taivitie "teaches that a first antenna terminal (43 through 51 in Fig. 5) [is] configured to connect the antenna to second antenna terminal (30 through 55 in Fig. 5) incorporated into the IC card when the IC card is inserted in the slot." See Office Action, page 2. Applicant disagrees. As

disclosed by Taivitie in Fig. 5, while antenna module 40 is separate from PCMCIA card 50 and becomes detached from PCMCIA card 50 when it is removed from antenna socket 51, this does not constitute at least “a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot,” as recited in claim 8 (emphasis added). Instead, as shown in Fig. 5 of Taivitie, either antenna module 40 is coupled to the PCMCIA card by installing antenna plug 43 in the antenna socket 51 or antenna connection 30 is coupled to the antenna socket 51. See col. 6, lines 4-9 and 39-49.

Furthermore, the Examiner conceded Taivitie does not disclose “a casing having a card slot for inserting an IC card.” Office Action, page 2. Since Taivitie does not teach “a casing having a card slot for inserting an IC card,” as the Examiner admitted, it also fails to teach “a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot,” as recited in claim 8 (emphasis added).

However, the Examiner alleged that Klatt discloses “a casing having a card slot for inserting an IC card” in Fig. 1 and at column 4, line 6 through column 5, line 56. See Office Action, page 2. While Klatt may disclose a card slot, the reference does not teach or suggest “a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot,” as recited in claim 8 (emphasis added).

Instead, as shown in Fig. 1 and described in the passages relied upon by the Examiner (col. 4, line 66 through col. 5, line 56), Klatt merely discloses that “chip card 9 can be inserted in the direction of the shown double arrow into the contacting unit 1.”

Col. 5, lines 16-18. However, the chip card reader shown in Fig. 1 of Klatt does not constitute “a first antenna terminal configured to connect the antenna to a second antenna terminal incorporated in the IC card when the IC card is inserted in the card slot,” as recited in claim 8 (emphasis added). Since Taivitie and Klatt, whether taken alone or in combination, fail to disclose all of the features of claim 8, the Examiner has not established a *prima facie* case of obviousness with respect to claim 8.

Furthermore, the Examiner alleges that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Taivitie system as taught by Klatt, [to] provide the motivation to achieve enhancing IC card protection in [a] communication system.” See Office Action, page 3. The Examiner’s allegation, however, is unsubstantiated by any factual evidence in the record, such as a competent prior art reference. Applicant respectfully notes that the required motivation to combine references must be found in the prior art. See M.P.E.P. § 2143. However, in the absence of a citation to a motivation arising from a prior art reference, a *prima facie* case of obviousness has not been made and the Examiner should withdraw the rejection for at least this reason. Accordingly, Applicant submits that the Examiner has not demonstrated the desirability of making any modification to result in Applicant’s claimed invention nor has the Examiner shown a reasonable expectation of success for so doing. The rejection of claim 8 is thus improper for at least these additional reasons and should be withdrawn.

Dependent claims 9 and 10 are also allowable at least due to their dependence from allowable claim 8. In addition, with regard to dependent claims 8 and 9, the Examiner alleged that Taivitie discloses that “the antenna is provided in an eject lever to

be operated to eject the IC card" and that "the antenna is provided on a surface of the casing." See Office Action, page 3. However, Taivitie is silent as to both the claimed "antenna ... provided in an eject lever" recited in claim 9, and the claimed "antenna provided on a surface of the casing" recited in claim 10. Klatt also does not cure the above deficiencies of Taivitie. Claims 9 and 10 are thus allowable for at least this additional reason. Accordingly, the Examiner should withdraw the rejection and allow claims 8-10.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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